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EXAMINER

CHANKONG, DOHM

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/051,340 | Applicant(s) CHAUVIN ET AL. | |
| | Examiner DOHM CHANKONG | Art Unit 2452 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-29, 31, 32 and 34-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-29, 31, 32, and 34-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to Applicant's arguments filed on 8/20/2008. Claims 23, 24, 28, 34-38, 42, and 43 are amended. Claims 23-29, 31, 32, and 34-43 are presented for further examination.

2. This is a final rejection.

Response to Arguments

I. DOUBLE PATENTING REJECTION OF CLAIMS 23-29, 31,32, AND 34-43

The double patenting rejection is withdrawn in light of Applicant's terminal disclaimer obviating a double patenting rejection over a pending second application filed on 4/20/2006.

II. INDEPENDENT CLAIMS 23, 34, AND 44

Applicant argues that the cited references do not disclose the following limitations: (1) an order terminal associated with one of a plurality of business entities; (2) identification of a storage device provider by electronically reading a code stored on the portable digital storage device; and (3) displaying an order screen on the order terminal in response to reading the code stored on the portable digital storage device. Applicant repeats the first argument against claim 34. Applicant's arguments have been considered but they are not persuasive because Reifel discloses the limitations as claimed.

A. Reifel discloses an order terminal associated with a print house.

As to (1), Applicant's argument hinges on what is meant by a terminal being

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“associated” with a business entity. This term is given its ordinary meaning consistent with the specification. Applicant argues that there is no teaching in Reifel for an order terminal associated with a print house. However, Reifel discloses that a user may specify from their order terminal which print house or vendor should be used to provide the prints [*column 5 «lines 29-30»*]. After doing so, the order terminal directs consumers to upload their pictures to specific servers associated with the selected print house or vendor [*column 6 «lines 20-23»*]. Thus, based on the user's selection, the terminal is associated with the selected print house and uploads the pictures to the associated server for storage and printing. Moreover, Reifel discloses additional businesses related to the print house such as a “print order taker” [*Figure 13 «item 50» | column 3 «lines 59-63»*]. This “order taker” business entity may also be associated with the order kiosk [*column 11 «lines 25-27»*]. Thus, Reifel discloses an order terminal associated with a business entity or merchant as claimed. And even if Reifel were deficient in teaching this limitation,, the secondary reference Mizumo discloses a variety of order terminals associated with different business entities [Figure 1 «items 30»].

B. Reifel discloses storing the electronic code identifying a storage device provider on a digital storage device.

Applicant argues that Reifel discloses that the "consumer creates a profile with the camera vendor describing the information about the storage device provider" which is then transferred to a print house but does not disclose identifying the storage device provider by reading the code stored on the portable digital storage device. Reifel clearly discloses that "camera-related information may be stored in the camera's memory" [*column 13 «lines 10-14»*]. This is beneficial because "whenever and from wherever the consumer logs into the server 26 to upload the images, the relevant profile information will accompany the images, *without*

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requiring the consumer to reenter the information" (emphasis added) [*column 13 «lines 2-6»*].

Thus, Reifel discloses storing storage device provider information as an electronic code on the portable digital storage device and reading the code from the portable device whenever and wherever the customer logs into the server.

C. Reifel discloses displaying an order screen based on identification of the storage device provider.

As to (3), Reifel discloses allowing a user to upload pictures and select associated printing services through the use of a kiosk display [*column 5 «lines 28-44» | column 19 «lines 33-45»*]. Reifel further discloses that the printing services provided on the order screen may be customized based on the specific identification of the storage device provider [*column 5 «lines 31-36»*]. Thus, if a storage device provider restricts the print house selection to specific print houses, the order screen for the user would be display differently than other users (only certain print houses would be displayed). Because the restriction of print houses is based on the storage device provider, there is an implication that the storage device provider must be identified so that the appropriate print houses can be selected.

III. DEPENDENT CLAIMS 24 AND 26

With respect to claim 24, Applicant also argues that Reifel fails to disclose “reading a second storage portable digital storage device having a second image stored thereon coupled to the network connected order terminal by the user.” The cited section in Reifel discloses that there are multiple camera providers that may use the disclosed invention. Read in combination with the previously cited sections, one of ordinary skill in the art would conclude that Reifel is teaching using different cameras from different camera providers. This reads on Applicant’s claim of a second storage portable digital storage device associated with a second storage device

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provider. Reifel discloses reading images from the portable digital storage devices [*column 6 «lines 20-23»*].

Furthermore, Applicant argues that "claim 26 calls for a particular type of order terminal." Claim 26 discloses an order terminal being any one of an automated teller machine, a kiosk, a personal computer, or a wireless device. Reifel discloses both an order kiosk [*column 19 «lines 33-45»*] and a personal computer [*Figure 13 «item 45»*].

IV. APPLICANT'S AMENDMENTS

Applicant has amended the claims replacing "storage device providers" with "service providers." This amendment does not affect the claims' scope because a "service provider" may still be interpreted as the previously written "storage device provider." A storage device provider gives the service of providing storage devices to its customers. The amendment seems to be purely cosmetic in nature with no affect to the scope of the claims. The amended claims are therefore interpreted in the same manner as the previous claims.

V. CONCLUSION

Based on the foregoing, Applicant's arguments are not persuasive. The rejections set forth in the previous action are therefore maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 23-27, 29, 31, 32, 34-37, and 39-44 are rejected under 35 U.S.C §103(a) as being unpatentable over Reifel et al, U.S Patent No. 7.013.288 [“Reifel”] in view of Mizumo, U.S. Patent Publication No. 2001|0021311.

4. As to claims 23, 34 and 44, Reifel discloses a method comprising:

providing a network service on a network [Figure 1];

allowing a user to access a network server via the network service for ordering products using a network connected order terminal, said order terminal associated with one of a plurality of business entities [Figure 1 | Figure 3 «item 308» | Figure 13 «items 20, 25»];

in response to a user coupling a portable digital storage device to a network connected order terminal [column 3 «lines 35-39»], electronically reading the portable digital device, the portable digital storage device associated with one of a plurality of service providers associated with the digital storage device and having an image stored thereon [column 3 «line 53» to column 4 «line 4» : manufacturers providing a camera to the user], said one of the plurality of the plurality of service providers identified by electronically reading a code stored on the portable digital storage device [column 12 «lines 29-38» | column 13 «lines 10-14» : camera-related information stored on the camera], the plurality of service providers each having a predefined business relationship with each of said plurality of business entities [column 5 «lines 28-44» | column 12 «line 6»];

maintaining relationship data indicating a rating of the predefined business relationships in a database coupled to the communication network [column 5 «lines 28-44» | column 12 «line

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6» : camera provider can restrict the vendors from which the consumer can receive services or the consumer can pay a higher fee to use those vendors not associated with the manufacturer]; and

displaying to the user an order screen on said order terminal in response to reading the code stored on the portable digital storage device, the order screen including primary purchasing information provided by at least two of said plurality of business entities from which the user can order a product and/or service related to the image stored on the portable digital storage device, the primary purchasing information being modified in response to a rating of a predefined business relationship between said one of the plurality of storage device providers and said at least two of the plurality of business entities [column 5 «lines 11-19 and 28-44» | column 12 «line 6» : Reifel discloses that a user may elect, by activating links to print houses or vendors that are approved by the camera provider or decide to use a lower rated vendor and pay a fee].

While Reifel discloses at least two business entities, one of which has a higher rating than the other [column 5 «lines 28-44» : a business entity that is preferred by the manufacturer of the device has a "higher" rating than a business entity that is not preferred], Reifel does not expressly disclose modifying an order screen such that the higher rated business entity is displayed first. However, this feature was well known in the art at the time of Applicant's invention as taught by Mizumo.

Like Reifel, Mizumo is directed towards a network photo-print service. Mizumo discloses an order screen whereby a user may select from a plurality of business entities [Figure 10 «item P5»]. Mizumo discloses that the order in which the entities are displayed based on certain conditions for the delivery site [0120, 0124]. While Mizumo does not disclose displaying

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a higher rated business first, one of ordinary skill in the art would have applied Mizumo's ordering features to Reifel's teachings. As noted above, Reifel discloses two business entities that have different relationships to a camera provider. It would have been obvious for one of ordinary skill in the art, in reading Mizumo, to have organized the order screen such that the preferred business entity (the business in which the manufacturer has a relationship) is listed prior to the business entity with whom the manufacturer does not have relationship [column 5 «lines 41-45»]. One would have been motivated to provide such a modification to Reifel's photo service because displaying preferred businesses first increases the possibility that the customer will see the better prices for printing the photographs.

5. As to claims 24, 35 and 42, Reifel discloses:

reading a second portable digital storage device having a second image stored thereon coupled to the network connected order terminal by the user, the second portable digital storage device associated with a second one of the plurality of service providers [column 3 «lines 65-67» : camera providers];

displaying to the user an order screen on said order terminal including second purchasing information for ordering said same product and/or service but for the image stored on the second portable digital storage device, the second purchasing information including a higher price for said product and/or service in response to a lower rating of a predefined business relationship between said second one of the storage providers and one of the business entities [column 5 «lines 29-44» : the discounts for prints based on the providers relationship with the print house].

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6. As to claims 25 and 37, Reifel discloses modifying the primary purchasing information to include a lower purchase price in response to better ratings of business relationships [column 5 «lines 28-44» | column 12 «line 6» : consumers receive cheaper prints at approved print houses or vendors].

7. As to claims 26 and 39, Reifel discloses said order terminal comprising one of the following, an automated teller machine, a kiosk, a personal computer, or a wireless device [Figure 13 «item 20»].

8. As to claims 27 and 41, Reifel discloses said portable digital storage device comprising one of the following: optical disc, magnetic floppy disk; flash memory device, or a digital camera [Figure 13 «items 5, 20»].

9. As to claims 29 and 40, Reifel discloses said one of a plurality of business entities provides one or more of the following: local printing of digital images, remote printing of digital images, on-line storage of digital images, providing digital storage media containing digital images, and providing associated goods and/or services with respect to hard copy prints [column 5 «lines 28-44»].

10. As to claim 31, Reifel discloses a potential rating of said predefined business relationships include at least two levels [column 5 «lines 28-44» : restricted vs. non-restricted print houses].

11. As to claim 32, Reifel discloses the step of maintaining relationship data is performed by a service manager using a table in a database of the server [Figure 13 «item 13»].

12. As to claims 36 and 43, Reifel discloses excluding merchants based on ratings of the business relationships between the service providers and the excluded merchants [column 1 «lines 61-66» : unauthorized print houses read on excluded merchants].

13. Claims 28 and 38 are rejected as being unpatentable over Reifel, in view of Vittal et al, U.S Patent No. 6.907.401 [“Vittal”].

14. As to claims 28 and 38, Reifel does not expressly disclose displaying different types of products and/or service on the order screen for the user to select, wherein some of the products and/or services are displayed more prominently based on said rating of a predefined business relationship between said one of the plurality of service providers and said one of a plurality of business entities. However, Vittal discloses that such a feature was well known at the time of Applicant’s invention. Vittal specifically discloses modifying purchasing information based on relationships between the merchant and a service provider such that the merchant’s product is displayed (advertised) more prominently [column 1 «lines 55-64» where : being advertised more prominently implies that that they are “displayed first”]. It would have been obvious to one of ordinary skill in the art to modify Reifel to include Vittal’s teachings of prominently displaying provider products on a merchant’s site based on a contract between the merchant and the service

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provider. One would have been motivated to modify Reifel as such functionality improves upon Reifel's merchant-service provider system by increasing the number of options in the merchant-provider contract.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571.272.3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dohm Chankong/
Primary Examiner, Art Unit 2452